

Patent
Attorney Docket: AUS920010310US1
(IBM/0011)

REMARKS

Claims 1, 9-10, 14, 16, 19-20, 23, 31-32, 36 and 38 stand objected to because of various informalities. Applicant has amended these claims to correct the informalities. Applicant respectfully requests reconsideration and withdrawal of the objections.

Claims 1, 3-4 and 10-16 stand rejected under 35 U.S.C. 101 for claiming an invention that is directed to non-statutory subject matter. The Examiner provides a two-prong approach to be used in determining whether a claimed invention is directed to statutory subject matter: 1) whether the invention is within the technological arts; and 2) whether the invention produces a useful, concrete and tangible result. (Office Action, ¶ 4, p. 5). The Examiner concludes that the second prong is satisfied, stating that the recited process produces a useful, concrete and tangible result. (Office Action, ¶ 4, p. 6).

As the MPEP states, for subject matter to be directed to statutory subject matter, the claimed process must be limited to a *practical application of the abstract idea* or mathematical algorithm in the technological arts. (MPEP, p. 2100-17). This is the requirement of the first prong of the test provided by the Examiner. A claim is limited to a *practical application* when the method, as claimed, produces a concrete, tangible and useful result, *i.e.* the method recites a step or act of producing something that is concrete, tangible and useful. (MPEP, p. 2100-18).

An example of a claim directed to statutory subject matter given in the MPEP is illustrative. "A digital filtering process for removing noise from a digital signal comprising the steps of calculating a mathematical algorithm to produce a correction signal and subtracting the correction signal from the digital signal to remove the noise." (MPEP, p. 2100-18). The MPEP provides this as an example of statutory subject matter. The MPEP determined that this example was directed towards statutory subject matter *regardless* of that fact that a person could use paper and pencil and provide the same result and regardless of the fact that there is nothing within the claim itself that shows the method is executed by a computer. By contrast, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory *because* there is no concrete, tangible and useful result. (MPEP, p. 2100-18).

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The Examiner further states that a process claim must apply, involve, use or advance the technological arts. The U.S. Supreme Court has made clear that Congress intended statutory subject matter to "include anything under the sun that is made by man." *Diamond v. Charkrabarty*, 447 U.S. 303, 308-309). As pointed out in the MPEP, the subject matter that courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature, and natural phenomenon. Because Applicant's claimed invention does not fall within one of these excluded areas, the invention that Applicant claims is directed to statutory subject matter. Applicant claims a method of doing business, and such methods are held to be statutory subject matter. See, *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352 (Fed. Cir. 1999).

Please note that Applicant has amended claims 1 and 23 to add technology structure that applies, involves, uses and advances the technological arts. Claims 1 and 23 have been amended to include the limitation of a computerized database.

Therefore, Applicant respectfully asserts that Applicant's claimed invention in claims 1, 9-10, 14, 16, 19-20, 23, 31-32, 36 and 38 are not the mere statement of an abstract idea and are therefore directed to statutory subject matter. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1, 3-4, 12, 17, 20-23, 25-26 and 34 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,526,575 issued to McCoy, *et al.* MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

MPEP § 2131

Applicant claims a method, system and computer program product for making syndicated content available on-line comprising, *inter alia*, maintaining an electronic database of previously registered content items that are available for distribution to or purchase by an online content purchaser and of distribution parameters associated with each of the previously registered content

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items; receiving a request to register an additional content item; determining whether there is a conflict; and registering the additional content item if there is no conflict. (Claims 1, 17, 23).

McCoy discloses a *scheduling* method for scheduling programming to be shown by a cable operator. A method for *scheduling* does not claim each and every limitation claimed by Applicant in Applicant's method that includes *registering*. McCoy discloses a method for placing programs and advertisements in a broadcasting schedule. McCoy does not disclose that the scheduled items are available for distribution or purchase by an online content purchaser, which is a limitation claimed by Applicant.

Furthermore, McCoy's method for scheduling determines *when* content will be distributed while Applicant's method of registering determines whether content *can* be distributed. McCoy does not disclose, although Applicant claims, that content can be registered for distribution only *if there is no conflict* between the distribution parameters. Since Applicant claims that content can only be registered when there is no conflict between the distribution parameters, then Applicant's claimed method does not allow content to be registered and distributed when there is a conflict. However, McCoy's method for *scheduling* content, for determining *when* content will be distributed, includes no determination whether or not the content *can* be distributed, or scheduled, by determining whether or not content distribution parameters conflict. Indeed, before McCoy's method of scheduling may be used, a determination must have already been made that the content to be scheduled *can be* and *will be* distributed or scheduled. The only question remaining for McCoy's method of scheduling is *when* the content will be distributed.

McCoy discloses that "lower" advertisements configured to interrupt the schedule at a certain frequency may be placed in the schedule as long as they do not conflict with the previously scheduled time slots for "higher" advertisements placed by the global and local absolute schedules. (McCoy, col, 16, ln. 64-67). McCoy does not disclose that the "lower" advertising content is distributed only if there is *no conflict*, a limitation claimed by Applicant. Instead, McCoy merely discloses that if *some* of the time slots within "a certain frequency" were previously scheduled with "higher" advertising content from the global schedule, then the "lower" advertising content would be distributed, or scheduled, at the remaining available time slots occurring at the certain frequency. McCoy discloses that the advertising content is accepted for distribution, or broadcast, even though

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there is a time parameter conflict when it is scheduled for some, but not all, of the timeslots. McCoy certainly does not disclose that advertisements are refused any time slot on the schedule simply because another advertisement is scheduled for a "first choice" time slot. If an advertisement has been sold, it will be scheduled. As stated above, McCoy makes no determination whether content *will be* distributed, only *when* it will be distributed.

Therefore, McCoy fails to disclose the following limitations claimed by Applicant: (1) that the content becomes available for distribution to an online content purchaser; and (2) that distribution parameters associated with different contents are used to determine whether there are conflicts between the different contents and then, contents are distributed only if *there are no conflicts*. Therefore, because McCoy does not disclose each and every limitation claimed by Applicant, a *prima facie* case of anticipation has not been presented. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 17 and 23 as well as of claims 3-4, 12, 20-22, 25-26 and 34 that depend, either directly or indirectly, from independent claims 1, 17 and 23.

Claims 2, 5-8, 24 and 27-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U.S. Patent 6,526,575 in view of Clark, U.S. Patent 5,311,423. Claims 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U.S. Patent 6,526,575 in view of Ansell et al., U.S. Patent 6,151,631. Claims 10-11, 13-16, 32-33 and 35-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., U.S. Patent 6,526,575 in view of Haddad, U.S. Patent 5,835,843. Based upon Applicant's request, *supra*, that the rejection of the independent claims 1, 17 and 23 be withdrawn, Applicant respectfully requests reconsideration and withdrawal of the rejections of the above claims because each of the above claims depends, either directly or indirectly, from the independent claims 1, 17 or 23.

Applicant thanks the Examiner for taking the time to discuss this response in a telephone interview. The interview included discussions of the rejections of claims based upon non-statutory subject matter and the disclosures and teachings of the cited prior art. These discussions were helpful in the preparation of this response.

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Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner believes that a telephone conference would help expedite the examination of this application, the Examiner is invited to telephone the below signed attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM/0011 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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